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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040501

Application Number: 09/930,320

Filing Date: August 15, 2001

Appellant(s): SHANA'A ET AL.

MAILED
MAY 05 2004
GROUP

ALAN BORNSTEIN
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 11, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims should stand together as one group.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US Patent 5,972,322	Rath et al.	October 26, 1999
US Patent 5,622,692	Rigg et al.	April 22, 1997
WO 98/30189	Stewart	July 16, 1998
US Patent 4,851,062	Tartaglione	July 25, 1989

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-11, 13-22, and 25-29 are rejected under 35 U.S.C. 103(a)
2. Claims 23 and 24 are rejected under 35 U.S.C. 103(a)

These rejections are fully set forth in prior office action, paper No. 12.

(11) *Response to Argument*

1. Claims 1-11, 13-22, and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Rath et al. (US 5,972,322, of record), in view of Rigg et al. (US 5,622,692, of record) and Stewart (WO98/30189).
2. Rath teaches a method for providing customized cosmetic product. The method comprising preparing the cosmetic product by combining separated components that are selected by the customer. (see the abstract.) The separated components include a base composition, and some variable ingredients, such as thickener, enhancing additive. See, particularly, col. 4, line 17-56, col. 6, line 29 to col. 7, line 2, col. 8, lines 23-42 (thickening agents); and col. 5, lines 4-24, col. 7, lines 31-47, and col. 9, line 14 to col. 10, line 37 (enhancing additives). Each of the separated components may contain a preservative, a polyhydric alcohol or a fragrance. (col. 12,

lines 43-47). The separate components are combined and mixed to obtain a homogeneous mixture (col. 13, lines 52-63).

3. For a composition containing a solvent, a solubilizing agent and a preservative, see the conditioner base disclosed at col. 5, line 44 to col. 6, line 8. For polyethylene glycol ethers of fatty alcohols and polysorbates as solubilizing agents see col. 5, lines 60-67. For the viscosity of the base compositions within the instantly claimed viscosity ranges see col. 3, lines 3-4, col. 5, lines 36-37, and col. 7, lines 58-59. For DMDM hydration and polyaminocarboxylic acid chelates (EDTA), see col. 13, lines 45-58, 66-67, Examples 9, 13, 14 and tables 16-21 at col. 17-23. The final composition may be prepared as a hair salon (at retail location) see col. 2, lines 34-36. The composition is packaged in containers (col. 13, lines 31-34). Rath also teaches various composition containing performance agents in varying amounts. See, col. 4, lines 28-30 and col. 9, line 26 to col. 13, line 5. Varying the amounts of the active agents is considered equivalent to provide a plurality of intensity levels as herein claimed. Several addition types of performance agents are disclosed. See, particularly, examples 8-15.

4. Rath does not teach expressly that the vehicles of each performance agent have at least two or three ingredients in common, a blank composition, a label identifying the components of the formulation, that the fragrance contain a solvent and at least one preservative in common, a label with code, a machine scannable bar code, the volume of the container, or the angle of the container' major axis during agitation.

However, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the same vehicles (such as solvent, preservative etc.) for each of the performance agents (e.g., thickener, fragrance), since Rath

teaches that each of the composition may contain the same components such as water, alcohols and preservatives. .

Further, Rigg et al. teaches providing a customized cosmetic composition in a container having a bar code label for identifying the customized composition. See, particularly, col. 2, lines 55-67, col. 4, lines 16-63. Stewart teaches a system and a method of preparing a customized, point-of-sale cosmetic composition. The method provide a base composition, and at least one of additives, each additive comprise plurality of variants. Commonly used additives include pH adjusters, oils, drying agents, anti-dandruff agents, salts, colors, fragrances moisturizers, gloss agents, etc. See, particularly, the abstract, pages 22-25 and the claims.

It is within the skill of artisan to add an inert solvent or diluents to a cosmetic composition to dilute the composition in order to achieve the desired strength or level of activity of the composition. Therefore, absent evidence of unexpected results, the addition of a blank composition having common ingredients with the performance agents is not considered critical. The volume of the container is not considered critical to the invention absent evidence to the contrary because it is within the skill of the artisan to select a container capable of holding an appropriate amount of composition. It is within the skill of artisan to adjust the angle of container during agitation to achieve the desired mixing, absent evidence to the contrary.

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention was made to prepare the composition of Rath using similar vehicle in a container with a bar code label as taught by Rigg et al. with the reasonable expectation of obtaining compatibility of the separate components for specialized treatment composition that can be identified for future use. It also would have been prima facie obvious to one of ordinary skill in

the art at the time the invention was made to employ more than one variable performance agents, including fragrance, colors, or benefit agents such as vitamins, antidandruff agent, in a customized composition as suggested by Stewart.

Claim 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rath et al. (US 5,972,322, of record), in view of Rigg et al. (US 5,622,692, of record) and Stewart (WO98/30189), and in further view of Tartaglione (US 4,851,062, of record).

Rath et al., Rigg et al. and Stewart teaches or suggests all the limitation of the claims as stated above. They do not teach expressly a container with a neck, a plug inserted in the neck and a cap, or container with a neck and a cap without an orifice.

However, Tartaglione teaches a container for packaging cosmetic composition that has a neck and a cap wherein the neck may be closed with a plug. See the abstract, column 1, lines 10-14, column 3, lines 39-41, 50-65 and column 4, lines 30-35.

Therefore it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to provide the composition as suggested by Rath et al., Rigg et al. and Stewart in a container with a plug and a cap as taught by Tartaglione expecting to provide cosmetic composition in containers with safety closure for preventing contamination of the contents.

5. In response to appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Particularly, the instant claims are directed to a method of providing customized cosmetic product by providing a base formula and

plurality of functional agents for customer to chose. The references on the record clearly teach such concept. Take the cited references as a whole, the claimed subject matter would have been fairly suggested.

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

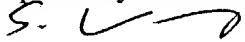
6. Appellants' arguments that whether thickener should be considered as variable or base ingredient in the claimed invention and/or in the cited references are irrelevant to the patentability of the instant application in view of the totality of the cited references. The cited references, as a whole, teach method of providing customized personal care products with a base formulation, and variables, which may be chosen by customers. Whether thickener should be a base (common) ingredient, or variable, is a matter that is within the skill of artisan, which would be obvious depending on the type of products and the population of customers. In fact the specification state: "the viscosity of the product base can be varied, from pourable liquid, to a thick paste or extrudable, depending on its composition and the amounts of thickener added to the base." The claimed invention does not have any limitation as to how much the thickener should be in the base, or whether the thickener should be excluded from the variable. Specifically, there is no clear definition of the "benefit agents" which would exclude thickener

(see pages 5-6 herein in the specification). To the contrary, the benefit agents herein include anything useful in the composition, from solvent to preservatives. Some of the exemplified agents are considered thickener in the art, such as propylene glycol or the like, and polyethylene glycol derivatives. See, the specification, pages 6, line 29 to page 7, line 20. The examiner has to give the claims a broad interpretation, particularly with respect to "performance agents," and "benefit agents."

7. As to the remarks that the base composition herein contains thickener, and therefore, thickener should be excluded from performance agent, note thickener is merely listed herein as one of a laundry list of agents (see page 4 line 30 to page 5 line 10). Note some of the exemplified performance agents herein are also in the list, e.g., emollients (page 6, lines 29-31).

8. In response to appellants' remarks that Stewart, or Rigg et al., does not teach expressly the variants have at least two ingredient in common, the examiner view such limitation as obvious to one of ordinary skill in the art. Particularly, each of the variants would have a similar carrier system, which would have essentially the same ingredients. See, particularly the color concentrates disclosed by Rath (example 16), wherein the concentrates have at least five ingredients in common.

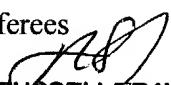
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Shengjun Wang
Primary Examiner
Art Unit 1617

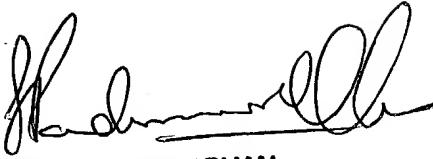
May 2, 2004

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